



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/812,700

03/30/2004

Ram Asokan

9314-70

4087

54414

7590

11/12/2008

MYERS BIGEL SIBLEY & SAJOVEC, P.A.

P.O. BOX 37428

RALEIGH, NC 27627

EXAMINER

BATISTA, MARCOS

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

11/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/812,700	Applicant(s) ASOKAN, RAM	
	Examiner MARCOS BATISTA	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 26-29, 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 26-29 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/25/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I (claims 1-12 and 26-29) in the reply filed on 09/05/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7-12, 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Koskinen et al. (EP 1096813 A2).

Consider claim 1, Koskinen discloses a wireless terminal participating in a packet-switched communications session to provide notice of receipt of an incoming circuit-switched call, comprising (**see fig. 1a, col. 7 lines 28-32 and 56-58, col. 8 lines 1-13**): receiving a paging request associated with the incoming circuit-switched call (**see col. 7 lines 32-56**); and notifying a server associated with the packet-switched communications session that the wireless terminal has received the incoming circuit switched call (**see col. 7 line 58, col. 8 lines 1-13**).

Consider claim 2, Koskinen discloses the invention of claim 1 above. Koskinen also discloses wherein notifying the server associated with the packet-switched communications session that the wireless terminal has received the incoming circuit-switched call comprises forwarding a notification message from the wireless terminal to the server over a circuit-switched channel (see col. 6 lines 25-29).

Consider claim 3, Koskinen discloses the invention of claim 2 above. Koskinen also discloses wherein the incoming circuit-switched call comprises a circuit-switched call transmitted over a GSM network, and wherein the circuit-switched channel is the SMS data bearer (see col. 1 lines 37-42, col. 6 lines 22-29).

Consider claim 4, Koskinen discloses the invention of claim 3 above. Koskinen also discloses wherein the notification message comprises a text message or an e-mail message transmitted over the SMS data bearer (see col. 1 lines 37-42).

Consider claim 5, Koskinen discloses the invention of claim 3 above. Koskinen also discloses wherein the notification message is forwarded via an IP level connection over the SMS data bearer (see col. 1 lines 37-42).

Consider claim 7, Koskinen discloses the invention of claim 1 above. Koskinen also discloses wherein notifying the server comprises forwarding a message from the

Art Unit: 2617

wireless terminal to the server associated with the packet-switched communications session (see col. 8 lines 1-13).

Consider claim 8, Koskinen discloses the invention of claim 1 above. Koskinen also discloses notifying the server associated with the packet-switched communications session upon termination of the incoming circuit-switched call (see col. 9 lines 41-47).

Consider claim 9, Koskinen discloses the invention of claim 8 above. Koskinen also discloses wherein the notification forwarded upon termination of the incoming circuit-switched call is forwarded over a circuit-switched channel (see col. 6 lines 25-29, col. 9 lines 41-47).

Consider claim 10, Koskinen discloses the invention of claim 8 above. Koskinen also discloses wherein the notification forwarded upon termination of the incoming circuit-switched call is forwarded over a packet-switched channel (see col. 8 lines 3-13, col. 9 lines 41-47)

Consider claim 11, Koskinen discloses the invention of claim 1 above. Koskinen also discloses notifying a remote terminal that the wireless terminal has temporarily suspended participation in the packet-switched communications session (see fig. 1a, col. 7 lines 56-58, col. 8 lines 1-13).

Consider claim 12, Koskinen discloses the invention of claim 1 above. Koskinen also discloses wherein notifying the server associated with the packet-switched communications session that the wireless terminal has received the incoming circuit switched call comprises forwarding a notification message from the wireless terminal to the server over a packet-switched channel prior to answering the incoming circuit-switched call (see col. 7 lines 56-58, col. 8 lines 1-13 and 16-19).

Consider claim 26, Koskinen discloses a transceiver (**fig. 2a, col. 6 lines 4-6**); and a packet-switched suspension notification circuit coupled to the transceiver that is configured to generate a notification message to a server controlling a packet-switched communications session when the wireless terminal temporarily suspends participation in the packet-switched communications session (**see fig. 2a, col. 7 lines 56-58, col. 8 lines 1-13**).

Consider claim 27, Koskinen discloses the invention of claim 26 above. Koskinen also discloses a circuit-switched communications circuit, wherein the packet-switched suspension notification circuit generates the notification message in response to receipt of a circuit-switched page by the circuit-switched communications circuit (**see fig. 2a, col. 7 lines 56-58, col. 8 lines 1-13**).

Consider claim 28, this claim discusses the same subject matter as claim 1. Therefore, it has been analyzed and rejected based upon the rejection to claim 1.

Consider claim 29, this claim discusses the same subject matter as claim 1. Therefore, it has been analyzed and rejected based upon the rejection to claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen et al. (EP 1096813 A2), hereafter "Koskinen," in view of Nasielski et al. (US 20050041640 A1), hereafter "Nasielski."

Consider claim 6, Koskinen discloses the invention as in claim 1 above.

Koskinen, however, does not particular refer to wherein the notification message includes an identification associated with the wireless terminal.

Nasielski, in analogous art, teaches a notification message that includes an identification associated with a wireless terminal (see par. 0032 lines 6-9).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen and have it include a notification message that includes an identification associated with a wireless terminal, as taught by Nasielski. The motivation would have been in order to determine the proper routing of the call (see par. 0032 lines 6-9).

7. Claim 31-35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen et al. (EP 1096813 A2), hereafter "Koskinen," in view of Crocker et al. (US 20050169223 A1), hereafter "Crocker."

Consider claim 31, Koskinen discloses the invention as in claim 1 above. Koskinen, however, does not particular refer to wherein the packet-switched communication session comprises a push-to-talk session.

Crocker, in analogous art, teaches a packet-switched communication session comprises a push-to-talk session (see fig. 2, par. 0033 lines 14-16).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen and have it include a packet-switched communication session comprises a push-to-talk session, as taught by Crocker. The motivation would have been in order to provide a more efficient bandwidth

Art Unit: 2617

utilization system for PTT sessions utilizing an IP-based protocol. (see par. 0008 lines 6-10).

Consider claim 32, Koskinen as modified by Crocker discloses the invention as in claim 31 above. Koskinen also discloses wherein notifying the server associated with the packet-switched communication session that the wireless terminal has received the incoming circuit-switched call includes notifying the server that wireless terminal has suspended the push-to-talk session (see col. 7 lines 56-58, col. 8 lines 1-13).

Consider claim 33, Koskinen as modified by Crocker discloses the invention as in claim 32 above. Koskinen also discloses wherein notifying the server associated with the packet-switched communication session that the wireless terminal has received the incoming circuit-switched call comprises notifying the server associated with the packet-switched communications session that the wireless terminal has received the incoming circuit switched call over a circuit-switched channel (see col. 6 lines 25-29).

Consider claim 34, Koskinen as modified by Crocker discloses the invention as in claim 33 above. Koskinen also discloses wherein the circuit-switched channel is the SMS data bearer (see col. 1 lines 37-42, col. 6 lines 22-29).

Consider claim 35, Koskinen as modified by Crocker discloses the invention as in claim 34 above. Koskinen also discloses wherein notifying the server associated with the packet-switched communication session that the wireless terminal has received the

Art Unit: 2617

incoming circuit-switched call comprises notifying the server associated with the packet-switched communications session that the wireless terminal has received the incoming circuit switched call over a packet-switched channel before the push-to-talk session is suspended (see col. 7 lines 56-58, col. 8 lines 1-13 and 16-19).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marcos Batista, whose telephone number is (571) 270-5209. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached at (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Marcos Batista
/M. B./

/Rafael Pérez-Gutiérrez/

Application/Control Number: 10/812,700

Page 11

Art Unit: 2617

Supervisory Patent Examiner, Art Unit 2617

11/06/2008